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JUL 3 1985
ALEXANDER STEVAS,

85- 20

No.

In the Supreme Court of the United States

October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

vs.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL APPENDIX TO PETITION FOR WRIT OF CERTIORARI

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July 6, 1985

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EXHIBIT 6

United States Patent [19]

Morgan

[11] **3,900,645**

[45] **Aug. 19, 1975**

[54] **SCORED ADHESIVE LAMINATE**

[75] Inventor: **Burton D. Morgan**, Hudson, Ohio

[73] Assignee: **Morgan Adhesives Company**, Stow, Ohio

[22] Filed: **Oct. 7, 1970**

[21] Appl. No. **78,887**

Related U.S. Application Data

[62] Division of Ser. No. 680,435, Dec. 11, 1967, Pat. No. 3,570,337.

[52] U.S. Cl. 428/41; 156/247

[51] Int. Cl. B32b 3/00

[58] Field of Search 229/56, 43; 161/167, 406, 161/116, 117

[56] **References Cited**

UNITED STATES PATENTS

1,967,444	7/1934	Lowe	161/406
2,303,346	12/1942	Flavel	161/406
2,606,141	8/1952	Eckman	156/257
3,008,792	10/1961	Wheeler	161/406
3,035,937	5/1962	Morgan	161/406
3,194,479	7/1965	Rumberger	229/43

Primary Examiner—George F. Lesmes
Assistant Examiner—R. J. Roche
Attorney, Agent, or Firm—Oldham & Oldham Co.

[57] **ABSTRACT**

Apparatus for scoring paper and other sheet materials which thereafter are formed into a laminate with an adhesive sheet. The scoring is not continuous but facilitates tearing the sheet at a later time to facilitate use of the laminate as a label or similar product.

4 Claims, 8 Drawing Figures

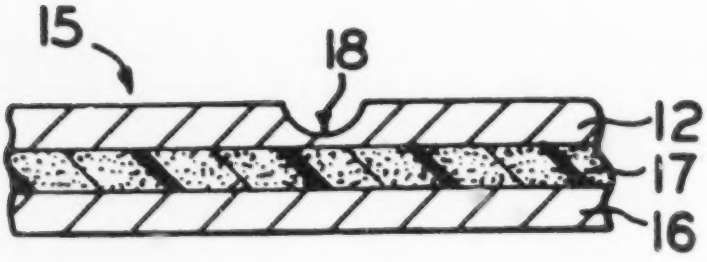


FIG. 1

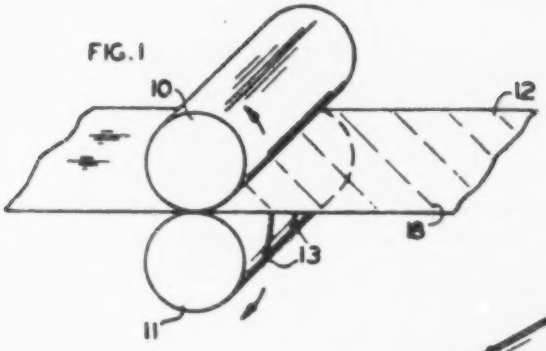
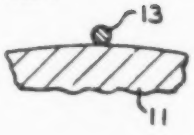


FIG. 4



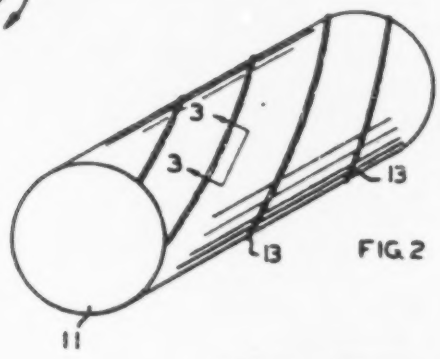


FIG. 2

FIG. 5

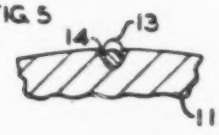


FIG. 3

FIG. 6

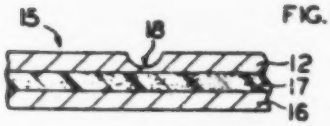
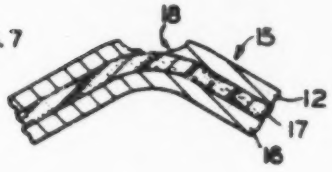


FIG. 8

FIG. 7



INVENTOR
BURTON D. MORGAN
BY Oldham & Oldham
ATTORNEYS

SCORED ADHESIVE LAMINATE

This is a division of my prior Application Serial No. [illegible] filed Dec. 11, 1967, now U.S. Pat. No. 3,570,137.

Reference is made to my own prior U.S. Pat. No. 3,039,917 which discloses one type of an adhesive product with special embossed tear zones provided therein.

This invention further relates to adhesive products such as labels, stickers, tapes and similar articles wherein the article comprises, normally, a surface sheet, a layer of adhesive secured to the back face of such surface sheet, and a removable paper backing sheet secured to the adhesive layer for ultimate removal when the label, sticker or the like is to be affixed to an article for end use purposes. It is difficult to strip labels, stickers and the like of their backing sheets to prepare them for use because no available edge of the backing sheet usually is exposed to facilitate grasping the backing sheet for its removal. U.S. Pat. No. 2,364,607 is one of the adhesive tape or label of this same general type as made heretofore, but which label or laminate provided does not in many instances accept printing uniformly.

The general object of the present invention is to provide a novel and improved laminate including a surface sheet, an adhesive layer, and a scored paper backing sheet which can readily be removed.

Another object of the invention is to form scored sheets of material, such as paper backing sheets, that are used in forming adhesive laminates or the like and wherein the backing sheet of the laminate must be removed before use of the product.

The foregoing and other objects and advantages of the invention will be made apparent as the specification proceeds.

Reference now is made to the accompanying drawings in which:

FIG. 1 is a perspective view of apparatus which is diagrammatically shown and used in forming a laminate of the invention.

FIG. 2 is an enlarged elevation of one of the rolls of FIG. 1.

FIG. 3 is a fragmentary enlarged section taken on line 3—3 of FIG. 2.

FIG. 4 is a fragmentary enlarged vertical section taken on line 4—4 of FIG. 3.

FIG. 5 is a fragmentary enlarged vertical section taken on line 5—5 of FIG. 3.

FIG. 6 is a fragmentary enlarged section of an adhesive laminate made using a sheet processed by the apparatus of FIG. 1.

FIG. 7 shows the step of splitting the adhesive laminate of FIG. 6 along a weakened area provided in the backing sheet of the laminate, and

FIG. 8 is an elevation of a modified roll of the apparatus.

When referring to corresponding members shown in the drawings and referred to in the specification, corresponding numerals are used to facilitate comparison therebetween.

Attention now is directed to the details of the structure shown in the drawings, and a pair of rolls 10 and 11, which normally are cylindrical and are made from metal, are shown in operative association to form a roll bight therebetween. Normally, at least one of the rolls is driven whereby pressure engagement is provided at

the roll bight for a sheet or strip of material 12 which will be drawn through the roll bight. Normally in the practice of use of the apparatus of the invention, the sheet or strip 12 would be formed from a fibrous material, such as paper, of the type that conventionally is used for forming backing sheets in adhesive laminates. Adhesive laminates using the sheets 12 may be used for making stickers, labels or other articles therefrom. Normally the sheets 12 are quite thin such as in the range of from about 0.001 inch to about 0.005 inches in thickness.

It is an important feature of the present invention that the roll 11 has one or more metal wires 13 secured to the surface thereof. These wires 13 preferably would be made from spring steel and, for example, would have a diameter of approximately 0.010 inch but the wire thickness can be varied dependent upon the thickness of the sheets 12 being processed and the desired amount of scoring to be provided thereon. The wire or wires 13 can be secured to the periphery of the roll 11 in any desired manner, as by spot welding or otherwise securing at least the ends of the wire 13 to the metal roll 11. However, if desired, the wire 11 could be affixed to the roll by a suitable adhesive, such as a conventional epoxy type of an adhesive which will set up at room temperature or at slightly elevated temperatures to give a good bond of the wire 13 to the roll. The wires are helically positioned on the roll 11.

It is another feature of the present invention that parts of the wires 13, at longitudinally spaced sections of the wire would have complementary shaped recesses 14 formed in the surface of the roll 11 for receiving a length of the wire 13 when the rolls 10 and 11 operatively engage whereby the wire 13 will not form a continuous scored or weakened area, zone or line in the sheet 12 being processed. Intermittent lengths of the sheet 12 would not be effected at all because the wire 13 would have sufficient resilience or stretch, and would have no backing provided therefor at the longitudinally spaced portions of the wires lying over the recesses 14 so that portions of the wire will just be pushed into the recesses 14 when the rolls engage. This particular construction of the wires and rolls leaves sufficient strength in the sheet 12 whereby it can be readily further processed without any danger of splitting or tearing while being processed or prepared for use. At the same time, the recesses 14 would only be provided at, for example, intervals of 1 or 2 inches along the periphery of the roll 11, and such recesses 14 necessarily could be quite short, such as approximately ¼ to ½ inch or so.

By passing the sheet 12 through the roll bight, the fibrous material forming the sheet 12 will be crushed or weakened by a compaction of the fibres in the sheet in lineal zones or lines 18 of the sheet where the wire 13 contacts it and where the wire is backed up by the surface of the roll 11.

FIG. 3 shows how a plurality of the small recesses 14 could be formed in the periphery of the roll for receiving longitudinally spaced portions of the wire 13 thereon when the roll 11 is operative. FIG. 5 in turn indicates how this wire can be received in the recess for passing portions of the sheet 12 through the roll bight without any scoring action on spaced areas of the sheet 12.

After the sheet 12 has been processed by being fed through the roll bight between the rolls 10 and 11, then

it can be thereafter treated in any conventional manner. Thus, for example, a layer of a release material of a conventional nature, such as a silicone base composition, can be applied to one surface of the sheet 12 and thereafter a laminate 15 can be made in a conventional manner and which laminate could, for example, include a surface layer 16, a layer of a conventional adhesive composition 17 attached to the layer 16, and then the release coated surface of the sheet 12 would be releasably affixed to the opposite face of the adhesive layer 17. Any desired pressure sensitive or other adhesives can be used in forming the laminate 15 and such adhesives may, for example, be of the compositions described on Page 506 of "Handbook of Adhesives" by Skeist.

After the laminate 15 has been fully prepared for use as by printing any desired data thereon after the laminate is made, or before the components thereof are assembled, as desired, then the laminate 15 can be cut to a desired shape, or otherwise be prepared for use. When the laminate is to be used, it is a relatively simple matter to fold or bend the laminate 15 in a direction as shown in FIG. 7 so as to tension the weakened zone or line 18 provided on the sheet 12 whereby such backing paper will split or tear along this line 18, the sheet 12 is removed, and the adhesive layer 17 can be exposed for securing the label product to a carrier surface for use. Thus, it is believed that the objects of the invention have been achieved and that a new and improved apparatus has been provided for creating or weakening ultimate tear lines or zones in sheet material, such as paper and the like, and a new laminate is provided.

In some instances, it may be desirable to use a roll such as a roll 20 shown in FIG. 8 rather than the roll 11 in combination with the roll 10 for forming weakened zones, areas or lines in a processed sheet of material. The roll 20 has wires 21 secured thereto similar to the wires 13. In this instance, however, the wires 21 may extend axially of the roll 20 inasmuch as the sheet material processed between the rolls 20 and 21 will still have sufficient strength for processing and handling even though spaced score lines or zones are provided in sheets of material processed between the rolls.

While several complete embodiments of the invention have been disclosed herein, it will be appreciated that modification of these particular embodiments of the invention may be resorted to without departing from the scope of the invention as defined in the appended claims.

What is claimed is:

1. A flexible laminate for use as a label, decal or the like, comprising

a face sheet,

a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and

a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, the paper having a release coating on its inner surface which engages the adhesive layer.

2. A laminate as in claim 1 where said backing sheet is weakened at said tear line.

3. A laminate as in claim 1 where the paper backing layer is less than one-half of its uncompacted thickness at said potential tear line.

4. A laminate as in claim 3 where the compaction of said paper layer is from its outer surface to provide a recess at said potential tear line on the outer surface of said paper layer.

* * * * *

MORGAN REISSUE APPLICATION

(Filed September 19, 1977)

REISSUE

5

9-[illegible]-77

834136	Patent Date		REISSUE PATENT NUMBER		
834,136	09/19/77	428	40	164	Van Balen

APPLICANT'S: DURTON D. MORGAN, HUDSON, OHIO

TITLE OF INVENTION: SCORED ADHESIVE LAMINATE

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627 FIRST NATL. TOWER
AKRON, OHIO 44308

ATTORNEY(S): JOHN L. OLDHAM, ET. AL.

ASSOCIATE ATTORNEY: NONE

SER. NO.	STATE OR COUNTRY	SHEETS DRAWING	TOTAL CLAIMS	INDEP. CLAIMS	FILING FEE RECEIVED	ATTORNEY'S DOCKET NO.	CLAIMS ALLOWED	CLASS	SUBCLASS
[illegible]	OH	1	[illegible]	[illegible]	[illegible]	[illegible]			

CONTINUING DATA: THIS APPLICATION IS A REISSUE OF PAT. NO. 3,900,651 A DIV OF S. 667,435, 12/11/67 PATENT 3,537,337.

FOREIGN APPLICATIONS: NONE

PATENT CONTRACTS SPECIFIED IN 35 USC 119 YES ☐ NO ☐

ASSIGNEE: MORGAN ADHESIVES COMPANY, STOW, OHIO, A CORP. OF OHIO

U.S. DEPT. OF COMMERCE - PATENT AND TRADEMARK OFFICE

PARTS OF APPLICATION FILED SEPARATELY

PREPARED FOR ISSUE

(Assistant Examiner) (Docket Clerk)

EXAMINED AND PASSED FOR ISSUE

(Primary Examiner) (Group)

Estimate of printed pages: Drawing [illegible] Sheet (s) [illegible] Issue fee due (___)

Number of allowance and issue fee due (___)

Date mailed

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834136

CONTENTS

1. Application _____ papers.
2. Title Report Sept 28 1977
3. Req for Lic Sept 15, 1977
4. Rely Granted Sept 22, 1977
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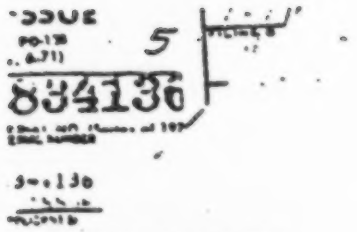


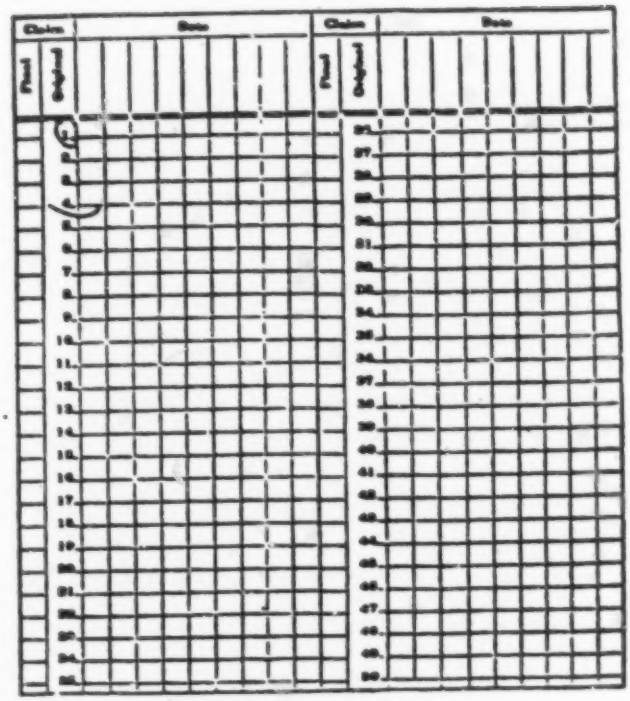
SEARCHED

Class	Sub	Date	Ex'r

INTERFERENCE SEARCHED

Class	Sub	Date	Ex'r

INDEX OF CLAIMS



SYMBOLS

STATUS

F_____ Rejected

=_____ Allowed

– (Through numeral)__ Canceled

C_____ Restriction requirement

N_____ Nonelected invention or species

I_____ Interference

A_____ Appeal

O_____ Objected

FORM PTO-875
(REV. 12-74)
(FORMERLY PTO-431)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION FEE DETERMINATION RECORD

SERIAL NUMBER	FILING DATE
834,136	9-19-77
APPLICANT (First Named Only)	
Morgan	

CLAIMS AS FILED - PART I

(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) BASIC FEE $65.00
TOTAL CLAIMS	-10=	0 *	x $2.00	
INDEPENDENT CLAIMS	- 1=	0 *	x $10.00	
			TOTAL FILING FEE →	65

CLAIMS AS AMENDED - PART II

	(1)	(2) CLAIMS REMAINING AFTER AMENDMENT	(3)	(4) HIGHEST NO PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
AMENDMENT	TOTAL	*	MINUS	**	=	x $2	=
	INDEP.	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			
AMENDMENT	TOTAL	*	MINUS	**	=	x $2	=
	INDEP.	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			
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	INDEP.	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			
AMENDMENT	TOTAL	*	MINUS	**	=	x $2	=
	INDEP	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 10, write "10" in this space.

The "Highest Number Previously Paid For" ("Total" or "Indep.") is the highest number found in the appropriate box in Column 2.

834136

SCORED ADHESIVE LAMINATE

ABSTRACT OF THE DISCLOSURE

Apparatus for scoring paper and other sheet materials which thereafter are formed into a laminate with an adhesive sheet. The scoring is not continuous but facilitates tearing the sheet at a later time to facilitate use of the laminate as a label or similar product.

09/27/77 034136 3 111 AS.00CK

SCORED ADHESIVE LAMINATE

This is a division of my prior Application Serial No. 689,435 filed December 11, 1967, now U.S. Patent No. 3,570,337.

Reference is made to my own prior U.S. Patent No. 3,035,957, which discloses one type of an adhesive product with special embrittled tear zones provided therein.

This invention further relates to adhesive products such as labels, stickers, tapes and similar articles wherein the article comprises, normally, a surface sheet, a layer of adhesive secured to the back face of such surface sheet, and a removable paper backing sheet secured to the adhesive layer for ultimate removal when the label, sticker or the like is to be affixed to an article for end use purposes. It is difficult to strip labels, stickers and the like of their backing sheets to prepare them for use because no available edge of the backing sheet usually is exposed to facilitate grasping the backing sheet for its removal. U.S. Patent No. 2,364,607 is on one adhesive tape or label of this same general type as made heretofore, but which label or laminate provided does not in many instances accept printing uniformly.

The general object of the present invention is to provide a novel and improved laminate including a surface sheet, an adhesive layer, and a scored paper backing sheet which can readily be removed.

Another object of the invention is to form scored sheets of material, such as paper backing sheets, that are used in forming adhesive laminates or the like and wherein the backing sheet of the laminate must be removed before use of the product.

The foregoing and other objects and advantages of the invention will be made apparent as the specification proceeds.

Reference now is made to the accompanying drawings in which:

Fig. 1 is a perspective view of apparatus which is diagrammatically shown and used in forming a laminate of the invention;

Fig. 2 is an enlarged elevation of one of the rolls of Fig. 1;

Fig. 3 is a fragmentary enlarged section taken on line 3-3 of Fig. 2;

Fig. 4 is a fragmentary enlarged vertical section taken on line 4-4 of Fig. 3;

Fig. 5 is a fragmentary enlarged vertical section taken on line 5-5 of Fig. 3;

Fig. 6 is a fragmentary enlarged section of an adhesive laminate made using a sheet processed by the apparatus of Fig. 1;

Fig. 7 shows the step of splitting the adhesive laminate of Fig. 6 along a weakened area provided in the backing sheet of the laminate; and

Fig. 8 is an elevation of a modified roll of the apparatus.

When referring to corresponding members shown in the drawings and referred to in the specification, corresponding numerals are used to facilitate comparison therebetween.

Attention now is directed to the details of the structure shown in the drawings, and a pair of rolls 10 and 11, which normally are cylindrical and are made from metal, are shown

in operative association to form a roll bight therebetween. Normally, at least one of the rolls is driven whereby pressure engagement is provided at the roll bight for a sheet or strip of material 12 which will be drawn through the roll bight. Normally in the process of use of the apparatus of the invention, the sheet or strip 12 would be formed from a fibrous material, such as paper, of the type that conventionally is used for forming backing sheets in adhesive laminates. Adhesive laminates using the sheets 12 may be used for making stickers, labels or other articles therefrom. Normally the sheets 12 are quite thin such as in the range of from about 0.001 inch to about 0.005 inches in thickness.

It is an important feature of the present invention that the roll 11 has one or more metal wires 13 secured to the surface thereof. These wires 13 preferably would be made from spring steel and, for example, would have a diameter of approximately 0.010 inch but the wire thickness can be varied dependent upon the thickness of the sheets 12 being processed and the desired amount of scoring to be provided thereon. The wire or wires 13 can be secured to the periphery of the roll 11 in any desired manner, as by spot welding or otherwise securing at least the ends of the wire 13 to the metal roll 11. However, if desired, the wire 11 could be affixed to the roll by a suitable adhesive, such as a conventional epoxy type of an adhesive which will set up at room temperature or at slightly elevated temperatures and give a good bond of the wire 13 to the roll. The wires are helically positioned on the roll 11.

It is another portion of the present invention that parts of the wires 13, at longitudinally spaced sections of th

wire would have complementary shaped recesses 14 formed in the surface of the roll 11 for receiving a length of the wire 13 when the rolls 10 and 11 operatively engage whereby the wire 13 will not form a continuous scored or weakened area, zone or line in the sheet 12 being processed. Intermittent lengths of the sheet 12 would not be effected at all because the wire 13 would have sufficient resilience or stretch, and would have no backing provided therefor at the longitudinally spaced portions of the wires lying over the recesses 14 so that portions of the wire will just be pushed into the recesses 14 when the rolls engage. This particular construction of the wires and rolls leaves sufficient strength in the sheet 12 whereby it can be readily further processed without any danger of splitting or tearing while being processed or prepared for use. At the same time, the recesses 14 would only be provided at, for example, intervals of 1 or 2 inches along the periphery of the roll 11, and such recesses 14 necessarily could be quite short, such as approximately 1/4 to 1/2 inch or so.

By passing the sheet 12 through the roll bight, the fibrous material forming the sheet 12 will be crushed or weakened by a compaction of the fibers in the sheet in lineal zones or lines 18 of the sheet where the wire 13 contacts it and where the wire is backed up by the surface of the roll 11.

Fig. 3 shows how a plurality of the small recesses 14 could be formed in the periphery of the roll for receiving longitudinally spaced portions of the wire 13 therein when the roll 11 is operative. Fig. 5 in turn indicates how this wire can be received in the recess for passing portions of the sheet 12 through the roll bight without any scoring action on spaced areas of the sheet 12.

After the sheet 12 has been processed by being fed through the roll bight between the rolls 10 and 11, then it can be thereafter treated in any conventional manner. Thus, for example, a layer of a release material of a conventional nature, such as a silicon base composition, can be applied to one surface of the sheet 12 and thereafter a laminate 15 can be made in a conventional manner and which laminate could, for example, include a surface layer 16, a layer of a conventional adhesive composition 17 attached to the layer 16, and then the release coated surface of the sheet 12 would be releasably affixed to the opposite face of the adhesive layer 17. Any desired pressure sensitive or other adhesives can be used in forming the laminate 15 and such adhesives may, for example, be of the composition described on Page 586 of "Handbook of Adhesives" by Skeist.

After the laminate 15 has been fully prepared for use as by printing any desired data thereon after the laminate is made, or before the components thereof are assembled, as desired, then the laminate 15 can be cut to a desired shape, or otherwise be prepared for use. When the laminate is to be used, it is a relatively simple matter to fold or bend the laminate 15 in a direction as shown in Fig. 7 so as to tension the weakened zone or line 18 provided on the sheet 12 whereby such backing paper will split or tear along this line 18, the sheet 12 is removed, and the adhesive layer 17 can be exposed for securing the end product to a carrier surface for use. Thus, it is believed that the objects of the invention have been achieved and that a new and improved apparatus has been provided for scoring or weakening ultimate

tear lines or zones in sheet material, such as paper and the like, and a new laminate is provided.

In some instances, it may be desirable to use a roll such as a roll 20 shown in Fig. 8 rather than the roll 11 in combination with the roll 10 for forming weakened zones, areas or lines in a processed sheet of material. The roll 20 has wires 21 secured thereto similar to the wires 13. In this instance, however, the wires 21 may extend axially of the roll 20 inasmuch as the sheet material processed between the rolls 20 and 21 will still have sufficient strength for processing and handling even though spaced score lines or zones are provided in sheets of material processed between the rolls.

While several complete embodiments of the invention have been disclosed herein, it will be appreciated that modification of these particular embodiments of the invention may be resorted to without departing from the scope of the invention as defined in the appended claims.

What is claimed is:

1. A flexible laminate for use as a label, decal or the like, comprising

a face sheet,

a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and

a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, the paper having a release coating on its inner surface which engages the adhesive layer.

2. A laminate as in Claim 1 where said backing sheet is weakened at said tear line.

3. A laminate as in Claim 1 where the paper backing layer is less than one-half of its uncompacted thickness at said potential tear line.

4. A laminate as in Claim 3 where the compaction of said paper layer is from its outer surface to provide a recess at said potential tear line on the outer surface of said paper layer.

DECLARATION, POWER OF ATTORNEY & PETITION

DECLARATION

Burton D. Morgan, the above-named petitioner, declares that he is a citizen of the United States of America, and a resident of Hudson in the State of Ohio; that he verily believes himself to be the original, first, and sole inventor of the invention described and claimed in Letters Patent No. 3,900,645 and in the foregoing specification and for which improvement he solicits a patent; that he does not know and does not believe that said improvement was ever known or used in the United States before his invention thereof, that he acknowledges a duty to disclose information of which he is aware which is material to the examination of the foregoing reissue application; and that he is aware of prior art which may be relevant to the patentability of his invention and which may not have been previously considered by the Patent Office, which might cause the Examiner to deem the original patent wholly or partially inoperative or invalid, to wit: U.S. Patent #3,230,649 to Korn, U.S. Patent #2,319,272 to Starr, U.S. Patent #2,434,545 to Brady, and U.S. Patent #2,681,732 to Brady; and that he requests that if the Examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

The undersigned petitioner declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor 's Full Name is Burton D. Morgan.

Burton D. Morgan

Date: 3 12 1977

Post office address 302 Aurora Street, Hudson, Ohio 44236

POWER OF ATTORNEY

Morgan Adhesives Company, 4560 Darrow Road, Stow, Ohio 44224, incorporated under the laws of the State of Ohio, the sole owner by assignment of United States Letters Patent No. 3,900,645, for "SCORED ADHESIVE LAMINATE", hereby appoints the firm of Oldham and Oldham Co., L.P.A., 627 First National Tower, Akron, Ohio 44308, telephone 216-762-6416, comprised of Vern L. Oldham, Registration No. 14,363; Edwin W. Oldham, Registration No. 22,003; Daniel J. Hudak, Registration No. 25,879; and Ray L. Weber, Registration No. 26,519, its attorneys, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

MORGAN ADHESIVES COMPANY

By: Blake H. Hooper
Blake H. Hooper, President
Chief Executive Officer

ATTEST:

By: F. Ward Ponser
F. Ward Ponser, Vice President & Treasurer

PETITION FOR REISSUE APPLICATION

Your petitioner, Burton D. Morgan, a citizen of the United States of America and a resident of Village of Hudson, State of Ohio, whose post office address is 302 Aurora Street, Hudson, Ohio 44236, prays that he may be allowed to surrender the Letters Patent for an improvement in SCORED ADHESIVE LAMINATE, No. 3,900,645, granted to him on August 19, 1975, whereof Morgan Adhesives Company, a corporation incorporated under the laws of the State of Ohio, on whose behalf and with whose assent this application is made, is now sole owner, by assignment, and that the Letters Patent may be reissued to the said Morgan Adhesives Company, for the same invention upon the following specification, With this Petition is filed an order for a title report, as required in such cases.

Burton D. Morgan

ASSENT OF ASSIGNEE TO REISSUE

The undersigned, assignee of the entire interest in the above-mentioned Letters Patent, hereby assents to the accompanying application.

MORGAN ADHESIVES COMPANY

By: _____
Blake H. Hooper, President

ATTEST:

_____
F. Ward Ponser, Vice President, Treasurer

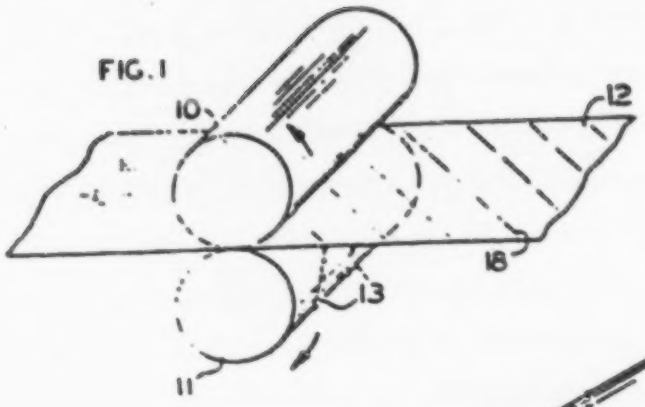


FIG. 1

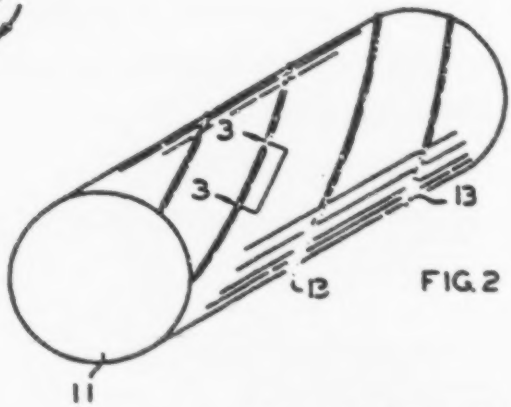


FIG. 2

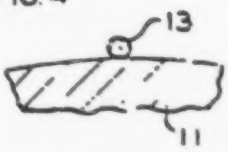


FIG. 4

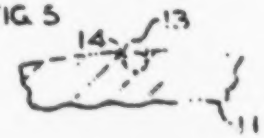


FIG. 5

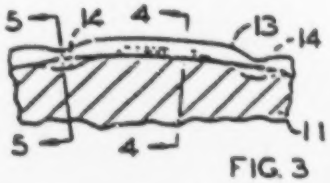


FIG. 3

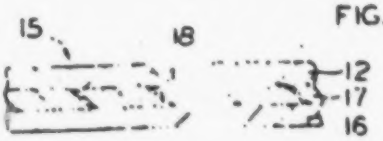


FIG. 6

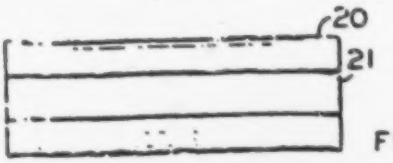


FIG. 8

FIG. 7

INVENTOR.
BURTON D. MORGAN

ATTORNEYS

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

TITLE REPORT

PAPER NO. 2

A. APPLICATION FILE DATA

(1.) SERIAL NO.

(2.) FILED

(3.) INVENTOR(S) - FULL NAME(S)

Burton D. Morgan.

(4.) DIVISION OF

(5.) CONTINUATION OF

(6.) REISSUE OF

(7.) SUBSTITUTE OF

B. ASSIGNMENT RECORD DATA

The assignment records reveal that the Title appears to be vested in:

(1.) ☐ INVENTOR(S)

(2.) ☐ AS ENDORSED

(3.) ☐ AS THE RECORD NOW STANDS, THE PATENT, WHEN GRANTED, WILL ISSUE IN THE NAME OF THE INVENTOR(S).

(4.) ☒ ~~OTHER~~

Morgan Lubricator Company
Lima, Ohio
Assignee of Ohio

EXAMINED TO AND INCLUDING 2-16-77

THIS CERTIFICATE DATED 2-28-77

HEAD OF ASSIGNMENT DIVISION Rec'd-2-28-77
S.M. HAYDEN (Rec'd 26 Pages 453. (N.J.A.

834136

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Burton D. Morgan Examiner:

Serial No.: Group Art Unit:

Filed:

For: "SCORED ADHESIVE LAMINATE" (New, reissue application)

Commissioner of Patents & Trademarks
Washington, D.C. 20231

CERTIFICATE OF MAILING

Sir:

This is to certify that the foregoing NEW, REISSUE PATENT APPLICATION was mailed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, with sufficient first-class U.S. postage prepaid no special handling charges, this 16th day of September, 1977, at approximately 4:00 PM, thereby ensuring that such document(s) will be in the hands of the U.S. Postal Service by the close of business this day. Thus, response has been made to the outstanding Patent Office action prior to expiration of the statutory period for the same ending NONE.

Respectfully submitted,

OLDHAM & OLDHAM CO. L.P.A.

By: Roy L. Walker

627 First National Tower, Akron, Ohio 44308

1-77-1-DIV-1

03413C

Commissioner of Patents & Trademarks
Washington, DC 20231

APPLICATION TRANSMITTAL LETTER

Sir:

Enclosed please find for filing a reissue patent appliration, based on U.S. Letters Patent No. 3,900,645, issued August 19, 1975, for "SCORED ADHESIVE LAMINATE," as follows:

INVENTOR: Burton D. Morgan

FOR: "SCORED ADHESIVE LAMINATE"

ENCLOSURES: Reissue application, comprised of seven pages specification, one page claims; original U.S. Letters Patent document; Declaration; Power of Attorney; Petition; informal drawing (copy of original drawing attached to bristol board); filing fee (by check).

The Commissioner is hereby requested to transfer the original drawings from the prosecution file to the reissue application file, and to prepare and furnish to the reissue application file a title report respecting U.S. Letters Patent No. 3,900,645.

The filing fee for the herein application is calculated to be $65.00 (4 claims total, 1 independent claim, no extra claims), and our check in this amount is enclosed.

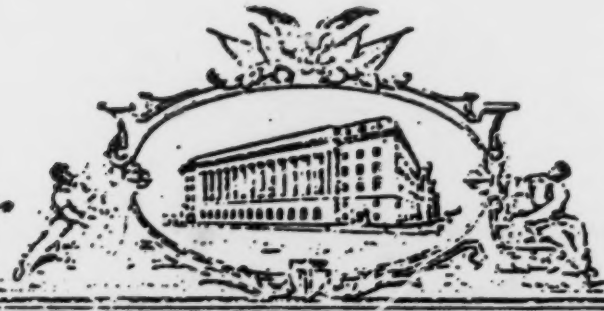
The Commissioner is authorized to charge any additional fees or credit any overpayments incident to the filing of this application to our Deposit Account No. 15-0450. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OLDHAM & OLDHAM CO. L.P.A.

By: Ray L. Weber

RLW/mr
Enclosures
627 First National Tower
Akron, Ohio 44308
Telephone: 216-762-6416
Docket No. J-2720-1-DIV-Re.



C21

3900645

UNITED STATES PATENT OFFICE

TO ALL TO WHOM THESE PRESENTS SHALL COME:

Whereas, THERE HAS BEEN PRESENTED TO THE

Commissioner of Patents and Trademarks

A PETITION PRAYING FOR THE GRANT OF LETTERS PATENT FOR AN ALLEGED NEW AND USEFUL INVENTION THE TITLE AND DESCRIPTION OF WHICH ARE CONTAINED IN THE SPECIFICATIONS OF WHICH A COPY IS HEREUNTO ANNEXED AND MADE A PART HEREOF, AND THE VARIOUS REQUIREMENTS OF LAW IN SUCH CASES MADE AND PROVIDED HAVE BEEN COMPLIED WITH, AND THE TITLE THERETO IS, FROM THE RECORDS OF THE PATENT AND TRADEMARK OFFICE IN THE CLAIMANT(S) INDICATED IN THE SAID COPY, AND WHEREAS, UPON DUE EXAMINATION MADE, THE SAID CLAIMANT(S) IS (ARE) ADJUDGED TO BE ENTITLED TO A PATENT UNDER THE LAW.

NOW, THEREFORE, THESE Letters Patent ARE TO GRANT UNTO THE SAID CLAIMANT(S) AND THE SUCCESSORS, HEIRS OR ASSIGNS OF THE SAID CLAIMANT(S) FOR THE TERM OF SEVENTEEN YEARS FROM THE DATE OF THIS GRANT, SUBJECT TO THE PAYMENT OF ISSUE FEES AS PROVIDED BY LAW, THE RIGHT TO EXCLUDE OTHERS FROM MAKING, USING OR SELLING THE SAID INVENTION THROUGHOUT THE UNITED STATES.

In testimony whereof *I have hereunto set my hand and caused the seal of the* Patent and Trademark Office *to be affixed at the City of Washington this* nineteenth *day of* August, *in the year of our Lord one thousand nine hundred and* seventy-five, *and of the Independence of the United States of America the two hundredth*

Acting Director

Commissioner of Patents and Trademarks

PATENT EXAMINER'S REJECTION OF REISSUE

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
ADDRESS: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

OCT 11 1978

[W. J. Van Balen Art Unit 164
834,136 09/19/77
Burton D. Morgan]

OCT 16 1978

Oldham & Oldham Co.
627 First NATL. Tower
Akron, Ohio 44308

☒ This application has been examined.
☐ Responsive to communication filed on _____.
☐ This action is made final.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 3 months
90 DAYS FROM THE DATE OF THIS LETTER.
FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BE ABANDONED

PART I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited, Form PTO-892.
2. ☐
3. ☐ Notice of Informal Patent Application, Form PTO-152
4. ☐

PART II SUMMARY OF ACTION

1. ☒ Claims 1-4 are pending in the application.
   Of the above claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-4 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The proposed drawings filed on _____ are accepted.
8. ☐ The drawings, corrected in response to the letter of _____ have been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119.
   ☐ Receipt is acknowledged of certified copies of priority documents which have been filed in parent application, serial no. _____, filed on _____.
   ☐ Receipt is acknowledged of certified copies of priority documents which have been received.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
11. ☐ Other

Form PTO-326 (rev. 11/77)

Serial No. 834,136
Art Unit 164

[2] Objection is made to the specification since there does not appear to be antecedent basis therein for the limitation in claim 3.

(1). Claims 1-4 are rejected under 35 USC 112, first paragraph for lack of an enabling disclosure. Apparatus for scoring the paper sheet is described in the specification as a roll 11 having one or more metal wires 13 secured to the surface thereof. Wires 13 are disclosed to be made from spring steel and are stated to have a diameter of approximately o.010 inch (i.e. edge radius of 0.005 inch). It is noted that the wire thickness can be varied depending upon the thickness of the sheets 12 being processed and the desired amount of scoring to be provided thereon; see specification page 3, lines 15-19. The score lines 18 imparted to paper sheet 12 (Figure 6) are the result of the wires 13 contacting sheet 12 through a crushing or weakening by compaction of the fibers in the sheet. It appears to be well known however, that steel wire having an edge radius of 0.005 inch (diameter of 0.01 inch) is sufficiently sharp to provide a knife edge for cutting the paper as opposed to compacting the sheet. For example, Bulletin 4010 of the Cameron Machine Company discloses that score cut knives are well known for slitting papers, laminates and the like. In the Cameron Bulletin, three knife edges are disclosed. These edges are indentified as edges "A", "B", and "C" with edge "B" having a radius of .006 to .008 inch. The "B" edge is thus slightly larger than the "A" edge which has a radius of .002 to .004 inch. The wire radius of the Morgan application (.005 inch) thus falls between the Cameron "A" edge and "B" edge and appears to be incapable of compacting or crushing paper.

[3] Rather the wire edge radius disclosed by Morgan seems to be a knife edge which will cut paper.

The term "score cut" as used in the Cameron Bulletin 4010 is well known in the industry. As pointed out in *Paper, Film and Foil Converter,* score cutting is an operation in which a score cut slitter is pressed against a hardened steel backup roll and the web of material passed between the wheel and the roll. As noted in the article, score cutting produces "a severing of the fibers by wheel pressure". (Page 24, column 2). As further noted in the article, the included angle of the score slitter may vary from 30 to 60 degrees and the radius of the wheel edge may vary from .002 inch to 0.12 inch depending upon the type of the material being slit. (Page 24, column 3). The edge radii as disclosed in the article are thus identical to the radii disclosed in the Cameron bulletin 4010. Since the apparatus disclosed herein appears to be a score cutting apparatus for slitting or cutting paper, there is no disclosure of how the wire wound roll apparatus acts to compact or crush rather than cut the paper. Thus, there appears to be no enabling disclosure which would permit one skilled in the art to practice the invention since the apparatus of the application seems to be a score cutting apparatus for cutting paper that doesn't differ in any material respect from Figure 1, *Paper, Film and Foil converter* article (page 24). The disclosure [4] is therefore totally deficient as to apparatus or means for achieving a crushed or compacted backing paper.

(2). Claims 1-4 are further rejected under 35 USC 112, first and second paragraphs. There is no antecedent basis for "the outer surface" in claim 4. The outer surface has not been defined with respect to an inner surface. Moreover, the only surface of a fiber paper backing layer having a reduced thickness potential tear line formed

in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, is that surface of the paper opposite the surface removably secured to an adhesive layer exemplified by Figures 6 and 7 in the drawing.

(3). Claims 1-4 are rejected under 35 USC 102(b) as clearly anticipated by Karn such as column 1, lines 8-12; column 2, lines 23-32; column 3, lines 51-64 and 70-73, and Figure 5. The "crush-cutting" technique of Karn (column 3, line 59) is presumed to yield appreciable compacting at the potential tear line. The "thin membranes" (column 3, line 59 and Figue 5) indicate that the paper backing layer is less than one-half of its uncompacted thickness at the potential tear line.

(4). Claims 1-4 are rejected under 35 USC 103 as obvious over Karn in view of Brady (732) or Brady, Jr. et al (545). This rejection assumes that the "potential tear line", score or indentation can be on that surface of the paper in contact with an adhesive. Each of Brady (732) such as Figure 3 and Brady (545) such as Figures 2 and 3 disclose a similar laminate having the tear line on the [5] adhesive side of the paper. For the tear line of Karn to be on the adhesive side of the paper would be obvious in view of Brady (732) or Brady (545).

(5). Claims 1-4 are rejected under 35 U.S.C. 103 as obvious over Karn in view of Cameron Machine Co. Bulletin 4010 and Paper, Film and Foil Converter Publication. This rejection assumes that there is some structural distinction in the configuration of the tear line of Karn. However, it would be obvious to employ the apparatus of the Bulletin 4010 and the Converter Publication which show rounded means conventionally used for scoring the paper of Karn.

(6). The Examiner has considered whether the disclosure is limited solely to forming interrupted score lines. Beginning at line 25 on page 2 through line 27 on page 3 and lines 3-12 on page 6 in the specification, there appears to be an enabling disclosure with reference to continuous score lines. The completeness of the disclosure in this respect is reinforced by the express teaching on page 3, lines 28 et seq. that in "another portion of the present invention that parts of wires 13, at longitudinally spaced sections of the wire would have complementary shaped recesses 14 formed in the surface of the roll 11 for receiving a length of wire 13 when the rolls 10 and 11 operatively engage whereby the wire 13 will not form a continuous scored or weakened area, zone or line in the sheet 12 being processed."

[6] The patent to Starr is not considered pertinent enough to use in a rejection because there is no disclosure therein of a paper backing nor a corresponding structure whereby the "fibers of the paper backing layer being appreciably compacted at the potential tear line" as claimed, notwithstanding the teaching in the patent of suitable lines of special weakness as by reducing the cross sectional area (column 3, lines 40-42) such as by suitably scoring, scorching, abrading or corroding (column 1, lines 19-22).

The prior art cited but not applied against the claims have been given careful consideration but is not seen to be as pertinent as the art that has been applied against the instant claims.

WJVanBalen:bh
(703) 557-1897
09/19/78

WILLIAM J. VAN BALEN
Examiner
Group Art Unit 164

TO SEPARATE, HOLD TOP AND BOTTOM EDGES APART AND DISCARD CARBON

FORM PTO-892 (Rev. 7-76) U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED

APPLICATION NO.	GROUP ART UNIT	ATTACHMENT
84,134		

APPLICANT(S)

U.S. PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
✓	A	2,319,272	5/1943	[illegible]	[illegible]	[illegible]
✓	B	4,134,545	1/1979	[illegible]	[illegible]	[illegible]
✓	C	2,636,247	4/1953	[illegible]	[illegible]	[illegible]
✓	D	2,681,729	6/1954	[illegible]	[illegible]	[illegible]
✓	E	2,800,144	7/1957	[illegible]	[illegible]	[illegible]
✓	F	2,956,703	10/1960	[illegible]	[illegible]	[illegible]
✓	G	3,006,011	10/1961	[illegible]	[illegible]	[illegible]
✓	H	3,028,870	4/1962	[illegible]	[illegible]	[illegible]
✓	I	3,031,259	4/1962	[illegible]	[illegible]	[illegible]
✓	J	3,035,577	5/1962	[illegible]	[illegible]	[illegible]
✓	K	3,043,309	7/1962	[illegible]	[illegible]	[illegible]

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUB CLASS
	L						
	M						
	N						
	O						
	P						
	Q						

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

✓	R	Bulletin 4010, Cameron Machine Co. [illegible] (no date)
✓	S	"Cage Type [illegible]" (1 page of 29-2)
	T	
	U	

EXAMINER: WILLIAM I. VAN BALEN

DATE

GROUP ART UNIT 104

A copy of this reference is not being furnished with the office action.
(See Manual of Patent Examining Procedure, section 707.05 (a).)

PATENT EXAMINER'S REJECTION OF AMENDED REISSUE APPLICATION

(Filed March 2, 1979)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
834,136	09/19/77	SURTON D. MORGAN	

ODLHAM & OLDHAM CO.
627 FIRST NATL. TOWER
AKRON, OHIO 44308

EXAMINER	
VAN BALEN	
ART UNIT	PAPER NUMBER
164	24

DATE MAILED: 2 MAR 1979

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☒ Responsive to communication filed on Jan. 16, 1979 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 months, ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of Reference Cited, Form PTO-892.
2. ☐ Notice of Informal Patent Drawing, PTO-948.
3. ☐ Notice of Informal Patent Application, Form PTO-152.
4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-4 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-4 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
   ☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____;
   filed on _____.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

PTOL-326 (rev. 10-78)

EXAMINER'S [redacted] ACTION

Art Unit 164
Serial No. 834,136

[2] 1. Objection is made to the entire amendatory matter inserted on Page 5, line 25 after the period for containing new matter and as being inaccurate and misdescriptive. 37 C.F.R. 175(d)(1) in part reads "the terms and phrases used in the claims must find clear support or antecedent basis in the description" (specification). The language acceptable to the Examiner is found in claim 3 beginning with "the" to the end of said claim. In the present amendment the plural form for "lines" and "are" are inaccurate and misdescriptive for Fig. 6. The expression "sheet 12 proper" is speculative as to what constitutes a "proper" sheet. Cancellation of the new matter is required.

2. Claims 1-4 are rejected under 35 USC 132 as being based on new matter or under 35 USC 112 first and second paragraphs for the reasons set out immediately above.

3. Applicant's arguments and affidavit together with exhibits filed January 10, 1978 have been given careful consideration, however, they are not deemed to be persuasive of any error for the position taken by the Examiner. The affidavit is insufficient for being highly opinionated and speculative at best. Further, the exhibits and affidavit point out the fact that, as a whole, undue experimentation was required such as constructing a wire wound roll, numerical thickness of paper (thickness not in exhibits), determination of properly applied pressure, determination of roll bight, concentricity of rolls, varying thickness of paper related to required pressure, load applied between rolls, design of rotary knife blade having a rounded edge, and edge radius of the blade.

[3] Applicant's affidavit together with exhibits is further not persuasive since it fails to present a side-by-side comparison with the Karn reference.

4. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph for the reasons set out in paragraph (1) of the previous Action mailed October 11, 1978. Hereafter referred to as "the previous Office Action".

5. Claims 1-3 are rejected under 35 USC 112, first and second paragraphs. The only disclosed surface of a fiber paper backing layer being appreciably compacted at the potential tear line, is that surface of the paper opposite the surface removably secured to an adhesive layer exemplified by Figures 6 and 7 in the drawing.

6. Claims 1-4 are rejected under 35 USC 102 (b) as clearly anticipated by Karn for the reasons set out in paragraph (3) of the previous Office Action.

7. Claims 1-3 are rejected under 35 USC 103 as obvious over Karn in view of Brady (732) or Brady, Jr. et al (545) for the reasons set out in paragraph (4) of the previous Office action.

8. Claims 1-4 are rejected under 35 U.S.C. 103 as obvious over Karn in view of Cameron Machine Co. Bulletin 4010 and Paper, Film and Foil Converter Publication for the reasons set out in paragraph (5) of the previous Office action.

This rejection is made FINAL.

WVANBALEN/dev
703/557/1952
February 28, 1979

/s/ W. J. Van Balen
Examiner
Group Art Unit 164

PATENT OFFICE EXAMINER'S REJECTION OF MORGAN'S SUPPLEMENTAL RESPONSE

(Filed July 9, 1979)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
834,136	09/19/77	BURTON D. MORGAN	NONE

EXAMINER
J. Van Balen

PAPER NUMBER
32

DATE MAILED
JUL 13 1979

OLDHAM & OLDHAM CO.
627 First Natl. Tower
Akron, Ohio 44308

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☒ Responsive to communication filed on May 9, 1979 and June 4, 1979. ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:
1. ☐ Notice of References Cited, PTO-892
2. ☐ Notice of Informal Patent Drawing, PTO-948
3. ☐ Notice of Informal Patent Application, Form PTO-152
4. ☐

Part II SUMMARY OF ACTION
1. ☒ Claims 1-4 are pending in the application.
   Of the above, claims ____ are withdrawn from consideration.
2. ☐ Claims ____ are allowed.
3. ☐ Claims ____ are rejected.
4. ☒ Claims 1-4 are subject to restriction or election requirement.
5. ☐ Claims ____ are objected to.
6. ☐ Claims ____ are subject to restriction or election requirement.
7. ☐ The proposed drawing(s) filed on ____ are acceptable.
8. ☐ The drawing correction request filed on ____ has been: ☐ approved ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
   ☐ been received ☐ been received in application serial no. ____ filed on ____
   ☐ been filed in parent application serial no. ____ filed on ____
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
11. ☐ Other.

PTOL-326 (rev. 10-78)

[2] The finality of the previous Office action mailed March 2, 1979 is withdrawn in order to amplify the Examiner's position and clarify the issues as per Applicant's request of May 9, 1979. A new statutory period of three months is set to commence with the mailing of this letter.

Applicant's arguments filed May 9, 1979 (paper No. 29) and June 4, 1979 (paper No. 31) have been given careful consideration; however, it is noted that no reply has been made to paragraphs *one* and *two* as set out in the final rejection dated March 2, 1979.

The Examiner's discussion below is keyed to the numbered paragraphs in the response filed June 4, 1979.

(Paragraph 1) Exhibits F1 and F2 correspond to Exhibits E1 and E2 filed March 17, 1978 (paper No. 9). No wire radius is given. Claims 1-4 are still rejected for lack of enabling disclosure as in the first Office action and as maintained in the previous final rejection. Instant Exhibit G refers to the type of paper used, i.e. "release paper" whereas Exhibit K2 refers to "stock paper". It is not known just what significance the respective papers have.

(Paragraphs 2 and 3) The qualifications of Robert C. McKee in paragraphs 1-12 of the Affidavit filed January 10, 1979 have never been in question. Paragraphs 13-28 have been considered insufficient for being highly opionated [sic] and speculative at best.

[3] (Paragraph 4) Exhibits H-K2 which are copies of the sworn deposition testimony of Jerome Wise (for protestor) firm up the opinion of the Examiner that beginning with the language "sketching a blade, knife, compacting roll, to produce the chemback product" in Exhibits H through K2 and including determination of variables such as applied pressure, shape and radius of the blade

to act upon the paper stock, appear to be undue experimentation, applicant's remarks on pages 6 and 7 of paper No. 21 filed January 10, 1979 to the contrary notwithstanding. Any further discussion regarding said exhibits is considered irrelevant since it is the Examiner's opinion that enablement of the instant disclosure and patentability of the claims are the issues to be decided.

(Paragraph 5) The proposition which provides that knife edges are neither cutting edges nor compacting edges merely by definition, but may be used in either mode by persons skilled in the art is incomplete. Exhibit I points up the fact that there is another mode i.e. "As soon as the air pressure was taken up sufficiently to compact, it also cut."

(Paragraphs 6 and 7) Karn such as column 1, lines 8-12; column 2, lines 23-32; column 3, lines 51-64 and 70-73, and Figure 5 is the evidence or factual basis of inherent compaction. Further, there is no actual disclosure in Karn that that which is cut is also removed to form the channels such as 25, 26, and 27. In light of the Karn disclosure the dictionary definition of the term "membrane" is too narrow.

[4] (Paragraph 8) 35 U.S.C. 282 begins with the statement, "A patent shall be presumed valid." In *Metropolitan Engineering Co. v. Coe,* 1935 C.D. 54, the court stated that "there is a presumption of operability to a patented device". Affidavits attacking the operability of a patent reference, though entitled to consideration are treated as an expression of the opinion by an expert in the art and are not conclusive of factual matters presented. In *In re Luerelle Guild,* 1953 C.D. 310, the C.C.P.A. said, "A patent enjoys a presumption of validity and a party attacking its validity on the ground of inoperativeness must establish his case by a preponderance of

proof. An ex parte affidavit, while not to be lightly disregarded, is seldom acceptable as being *conclusive* of the factual matter stated therein, and, in general, such affidavits are accorded the status of an expression of opinion by an expert in the art." In *In re Pappas et al.*, 1954 C.D. 278, the C.C.P.A. stated, "We have studied the affidavit carefully but fail to find any factual data set out therein . . . An affidavit which is merely a statement of the affiant's opinion is not entitled to any weight." In *In re Reid, 1950 C.D. 194*, affidavits were submitted by the assignee giving opinions as to what the references disclosed and also the reports of experiments which were said to show that the disclosure of the patents produced inoperative or unsatisfactory results. The opinion portions were inadmissible.

[5] (Paragraph 9) The affidavit must set forth facts and not merely conclusions. In *In re Pike et al.*, 1950 C.D. 105, two affidavits were submitted. The critical deficiencies of one affidavit were pointed out by the Primary Examiner who, among other things, observed that no comparative data was submitted in the affidavit with respect to the actual adhesiveness of specific compositions, including the sample submitted. The examiner concluded that the affidavits were unsupported by factual evidence, both the board and the C.C.P.A. agreed.

The facts presented in the affidavits must be pertinent to the rejection; otherwise, the affidavits have no probative value. In *In re Renstrom*, 1949 C.D. 306, an affidavit was submitted, pointing out advantages of the article claimed over those formerly produced at the plant where appellant was employed, but the C.C.P.A. held that since it did not appear from the records that articles were made in accordance with the Soloman patent, used for rejection,

such advantages were not material to the issue of patentability of the appealed claims over the patent.

Thus the instant application fails to present a side-by-side comparison with the product of the Karn reference in order to avoid the application of Karn against the claims under 35 U.S.C. 103.

The previous objections and rejections of all claims as set out in paragraphs 1-8 of the previous Office action mailed March 2, 1979 are maintained.

This rejection is made *FINAL*.

/s/ W. J. Van Balen
Examiner
Group Art Unit 164

/s/ George F. Lesmes
Supervisory Patent Examiner
Art Unit 164

WJ Van Balen:pc
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7/9/79

PATENT OFFICE EXAMINER'S REJECTION OF AMENDED REISSUE APPLICATION

(Filed November 16, 1979)

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 34

Mailed

NOV 16 1979

In Reply Please Refer To The Following:		
EXAMINER'S NAME	W. J. Van Balen	
164	09-19-77	834,136
GR ART UN	FILING DATE	SERIAL NO
BURTON D. MORGAN		
APPLICANT		INVENTION
SCORED ADHESIVE LAMINATE		

Oldham and Oldham Co.,
627 First Natl. Tower
Akron, OH 44308

Below is a communication from the EXAMINER in charge of this application

Commissioner of Patents and Trademarks

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE IS EXTENDED TO RUN 6 MONTHS FROM THE DATE OF THE FINAL REJECTION. 855 O.G. 1109

☐ Appellant's Brief is due in accordance with Rule 192(a).

Applicant's response to the final rejection, filed _____, has been considered with the following effect, but it is not deemed to place the application in condition for allowance.

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
   a. ☐ There is no convincing showing under Rule 116(b).
   b. ☐ They raise new issues that would require further consideration and/or search.
   c. ☐ They raise the issue of new matter.
   d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
   e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing of an appeal, the proposed amendment ☒ will be ☐ will not be entered and the status of the claims in this application would be as follows:
   a. ☒ Claims None would be allowable.
   b. ☒ Claims 1-4 would not be allowable.
   However,
   (1) ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
   (2) ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☐ The affidavit, exhibit or request for reconsideration has been entered but does not overcome the rejection.

5. ☐ The affidavit or exhibit will not be admitted because applicant has not shown good and sufficient reasons why it was not earlier presented.

6. ☐ The application having been examined under the special accelerated examining procedure (M.P.E.P. 708.02), the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better condition for appeal.

[2] If the amendment as proposed were entered paragraphs 1 and 2 of the Office action mailed March 2, 1979, would be withdrawn. Accordingly, near the bottom of page 5 of the final rejection mailed July 13, 1979, the expression "as set out in paragraphs 1-8" would be modified to "as set out in paragraphs 3-8 of the previous Office action mailed March 2, 1979 are maintained."

Applicant has urged that the principal concept of the invention is compacting potential tear lines or break point of embrittlement such that they crack or break when bent. However, in the specification generally, and more specifically on page 4, lines 18-22, reference is made to the fibrous material forming the sheet as crushed or weakened by compaction of fibers in the sheet in lineal zones or lines. There is no actual disclosure to said "embrittlement" feature. It further appears that the compacted fibers "split or tear" as disclosed on page 5, lines 20-25 in the specification rather than crack or break as urged.

The affidavit of Robert C. McKee filed October 15, 1979 under 37 CFR 132 has been given careful consideration. The affidavit is held to be insufficient because (1) a steel wire having a diameter of 0.012 inch would have an edge radius of 0.006 inch (i.e. 1/2 of diameter = radius) which corresponds to the "B" edge in the Cameron Bulletin of record whereas the instant disclosure refers to the wire as having a diameter [3] of approximately 0.010 inch (edge radius of 0.005 inch) which is well known to be sufficiently sharp to provide a knife edge for cutting paper. The 0.005 inch edge radius falls between the Cameron "A" edge and "B" edge. Accordingly, it is not seen how the 0.012 inch diameter wire conforms to the teachings of this application and it is not seen how it should

function in the same manner as a wire having a diameter of 0.010 inch. (2) paper fiber network compacted to "embrittlement" is not actually disclosed. (3) there are no good and sufficient reasons given for using a rotary score cut knife having an edge radius of 0.002-0.003 inch or a razor blade in attempting to follow the teachings of the Karn patent 3,230,649, especially column 3, lines 59 et seq. and Figure 5. An edge radius of 0.002-0.003 inch falls within the range of 0.002-0.004 inch "A" edge of the Cameron Bulletin. The "B" and "C" edge radii of the Cameron Bulletin were not used in attempting to follow the teachings of Karn loc. cit. supra. (4) The pressures in all instances are uninformative since there are mere broad references to adjusting pressures without regard to their frequency and numerical values so that a direct comparison is impossible. Thus, the instant affidavits lack factual evidence. In re Fay and Fox, 146 USPQ 47; In re Metcalf et al, 157 USPQ 423 and In re Andrews, 168 USPQ 360, cited by applicant, supporting the examiner's position. Where the comparison is not identical with the reference disclosure, deviations therefrom should be satisfactorily explained. In re Finley, 81 USPQ 383 (CCPA).

[4] A telephone interview between Mr. Ray Weber and the Examiner was held on November 13, 1979. Mr. Weber alleged that column 3, lines 59-62 were inconsistent with column 3, lines 63-69 in Karn, i.e. crush-cutting rotary knives as opposed to a die cutting operation. The Examiner's position was and always has been that the crush-cutting inherently includes compaction of the fibers resulting in thin membranes in the channels. Note Figure

5. The Examiner further noted that no product samples were filed with the affidavit.

/s/ W. J. VAN BALEN
Examiner
Group Art Unit 164

/s/ GEORGE F. LESMES
Supervisory Patent Examiner
Art Unit 164

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11-16-79